UNITED STATES PATENT AND TRADEMARK OFFICE

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			EXAMINER
25181	7590	08/28/2006	WASSUM, LUKE S

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DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 July 2006*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 July 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   The Applicants' amendment, filed 13 July 2006, has been received, entered into

the record, and considered.

2.   As a result of the amendment, claims 1, 11 and 24 have been amended. Claims 1-

28 remain pending in the application.

Priority

3.   The examiner acknowledges the Applicants' claim to domestic priority under 35

U.S.C. § 119(e) to provisional U.S. Patent Application 60/397,542, filed 22 July 2002.

4.   The examiner notes, however, that the provisional application is substantially

more limited in its teaching than the instant application. At the least, the provisional

application fails to disclose any aspect of analysis involving non-patent publications,

association of times with data elements, and also fails to disclose any graphical display

of the analysis results.

As a result, *at least* claims 4-7, 8-10, 12, 13 and 15-17 are not entitled to the priority

date of the provisional application, since the limitations claimed are not supported by

the disclosure of the cited provisional application.

The Invention

5.   The claimed invention is a system for searching databases to identify a set of data

elements referenced by a starting data element, and identifying a second set of data

elements that are referenced by data elements in the first set.

Drawings

6.   The drawings are objected to because Figures 2-4 contain hand-written additions.

While these drawings are acceptable for examination purposes, the examiner

encourages the Applicant to submit formal drawings at the earliest opportunity. Early

submission of formal drawings will help expedite post-allowance processing and

publication of any issued patent.

7.   Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in

reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the

immediate prior version of the sheet, even if only one figure is being amended. The

figure or figure number of an amended drawing should not be labeled as "amended."

If a drawing figure is to be canceled, the appropriate figure must be removed from the

replacement sheet, and where necessary, the remaining figures must be renumbered

and appropriate changes made to the brief description of the several views of the

drawings for consistency. Additional replacement sheets may be necessary to show the

renumbering of the remaining figures. Each drawing sheet submitted after the filing

date of an application must be labeled in the top margin as either "Replacement Sheet"

or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

examiner, the applicant will be notified and informed of any required corrective action

in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

8.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

9.   Claims 1-6, 11-13 and 17-28 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

10.   Regarding claims 1, 11 and 24, these claims recite the process of identifying data

elements and relationships therebetween, but fails to recite a tangible result, a

requirement for compliance with the provisions of 35 U.S.C. § 101 for a process that can

be interpreted as being implemented through software.

        For a result to be tangible, it must be more than just a thought or a computation;

it must have real-world value rather than an abstract result. For instance, note that the

limitations of claims 7-10 and 14-16 are not rejected, since they recite the function of

displaying the data resulting from the operation to a user, whereas (for instance), claim

1 merely cites 'generating data' as the result.

        This interpretation of 35 U.S.C. § 101 is consistent with the Interim Guidelines for

Examination of Patent Applications for Patent Subject Matter Eligibility, published on

26 October 2005, which can be found at

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.

pdf, particularly with respect to ANNEX IV Computer-Related Nonstatutory Subject

Matter, beginning on page 50.

11.   Claims 2-6, 12, 13, 17-23 and 25-28, fully incorporating the deficiencies of their

respective independent claims, are likewise rejected.

Claim Rejections - 35 USC § 102

12.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13.   Claims 1-9, 11-16 and 18-28 are rejected under 35 U.S.C. 102(b) as being

anticipated by **Rivette et al.** (U.S. Patent 6,339,767).

14.   Regarding claim 1, **Rivette et al.** teaches a method of searching a database of data

elements as claimed, the method comprising:

> a) based on a starting data element, identifying a first set of one or more data
>
>   elements in the database, the data elements of the first set being referenced
>
>   by the starting data element (see disclosure of the PatentRef table storing
>
>   information on U.S. Patents cited during the prosecution of a given patent,

col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing

Figure 40; see also detailed description of the Patent Citation Module, col.

87, line 4 through col. 89, line 53, which operates to identify, for a particular

patent [called a source patent], the patents which were cited during

prosecution of the selected patent [backwards citation report], col. 87, lines

4-10, as well as identifying for a source patent those patents in which the

source patent was cited [forward citation report], col. 87, lines 11-15; see

also drawing Figures 86 and 87);

b) based on the first set, identifying a second set of one or more data elements in

the database, the data elements of the second ser referencing one or more of

the data elements of the first set (see disclosure of the PatentRef table

storing information on U.S. Patents cited during the prosecution of a given

patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in

drawing Figure 40; see also detailed description of the Patent Citation

Module, col. 87, line 4 through col. 89, line 53, which operates to identify,

for a particular patent [called a source patent], the patents which were cited

during prosecution of the selected patent [backwards citation report], col.

87, lines 4-10, as well as identifying for a source patent those patents in

which the source patent was cited [forward citation report], col. 87, lines 11-

15; see also drawing Figures 86 and 87);

c) generating data based on the data elements of the first and second sets and the

relationships therebetween (see disclosure of the PatentRef table storing

information on U.S. Patents cited during the prosecution of a given patent,

col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing

Figure 40; see also detailed description of the Patent Citation Module, col.

87, line 4 through col. 89, line 53, which operates to identify, for a particular

patent [called a source patent], the patents which were cited during

prosecution of the selected patent [backwards citation report], col. 87, lines

4-10, as well as identifying for a source patent those patents in which the

source patent was cited [forward citation report], col. 87, lines 11-15; see

also drawing Figures 86 and 87); and

d) the second set being identified by recursive searching in which any successive

search is capable of being contracted, expanded and/or otherwise modified

to include one or more generations of interrelated data elements (see

disclosure that the patent citation report can be performed and displayed

in a recursive fashion with an operator specified depth, col. 88, line 65

through col. 89, line 21).

15.   Regarding claim 11, **Rivette et al.** teaches a method of searching a database to

identify prior art publications for a starting patent publication as claimed, the method

comprising:

   a) based on the starting patent publication, identifying a first set of one or more

   publications in the database, the publications of the first set being cited by

   the starting patent publication (see disclosure of the PatentRef table storing

   information on U.S. Patents cited during the prosecution of a given patent,

   col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing

   Figure 40; see also detailed description of the Patent Citation Module, col.

   87, line 4 through col. 89, line 53, which operates to identify, for a particular

   patent [called a source patent], the patents which were cited during

   prosecution of the selected patent [backwards citation report], col. 87, lines

   4-10; see also drawing Figure 86);

   b) based on the first set, identifying a second set of one or more publications in

   the database, the publications of the second set citing one or more of the

   publications of the first set (see disclosure of the PatentRef table storing

   information on U.S. Patents cited during the prosecution of a given patent,

col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing

Figure 40; see also detailed description of the Patent Citation Module, col.

87, line 4 through col. 89, line 53, which operates to identify, for a particular

patent [called a source patent], the patents in which the source patent was

cited [forward citation report], col. 87, lines 11-15; see also drawing Figure

87);

c) generating data based on the publications of the first and second sets and the

citation relationships therebetween (see disclosure of the PatentRef table

storing information on U.S. Patents cited during the prosecution of a given

patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in

drawing Figure 40; see also detailed description of the Patent Citation

Module, col. 87, line 4 through col. 89, line 53, which operates to identify,

for a particular patent [called a source patent], the patents which were cited

during prosecution of the selected patent [backwards citation report], col.

87, lines 4-10, as well as identifying for a source patent those patents in

which the source patent was cited [forward citation report], col. 87, lines 11-

15; see also drawing Figures 86 and 87); and

d) the second set being identified by recursive searching in which any successive

search is capable of being contracted, expanded and/or otherwise modified

to include one or more generations of interrelated data elements (see

disclosure that the patent citation report can be performed and displayed

in a recursive fashion with an operator specified depth, col. 88, line 65

through col. 89, line 21).

16.   Regarding claim 24, **Rivette et al.** teaches a processor program for searching a

database to identify prior art publications for a starting patent publication as claimed,

the processor program being stored on a processor readable medium and comprising

instructions to cause the processor to:

> a) based on the starting patent publication, identify a first set of one or more
>
>   publications in the database, the publications of the first set being cited by
>
>   the starting publication (see disclosure of the PatentRef table storing
>
>   information on U.S. Patents cited during the prosecution of a given patent,
>
>   col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing
>
>   Figure 40; see also detailed description of the Patent Citation Module, col.
>
>   87, line 4 through col. 89, line 53, which operates to identify, for a particular
>
>   patent [called a source patent], the patents which were cited during

prosecution of the selected patent [backwards citation report], col. 87, lines

4-10; see also drawing Figure 86);

b) based on the first set, identify a second set of one or more publications in the

database, the publications of the second set citing one or more of the

publications of the first set (see disclosure of the PatentRef table storing

information on U.S. Patents cited during the prosecution of a given patent,

col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing

Figure 40; see also detailed description of the Patent Citation Module, col.

87, line 4 through col. 89, line 53, which operates to identify, for a particular

patent [called a source patent], the patents in which the source patent was

cited [forward citation report], col. 87, lines 11-15; see also drawing Figure

87);

c) generate data based on the publications of the first and second sets and the

relationship therebetween (see disclosure of the PatentRef table storing

information on U.S. Patents cited during the prosecution of a given patent,

col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing

Figure 40; see also detailed description of the Patent Citation Module, col.

87, line 4 through col. 89, line 53, which operates to identify, for a particular

patent [called a source patent], the patents which were cited during

prosecution of the selected patent [backwards citation report], col. 87, lines

4-10, as well as identifying for a source patent those patents in which the

source patent was cited [forward citation report], col. 87, lines 11-15; see

also drawing Figures 86 and 87); and

d) wherein said instructions are further capable of causing the processor to

identify the second set by recursive searching in which any successive

search is capable of being contracted, expanded and/or otherwise modified

to include one or more generations of interrelated data elements (see

disclosure that the patent citation report can be performed and displayed

in a recursive fashion with an operator specified depth, col. 88, line 65

through col. 89, line 21).

17.   Regarding claim 2, **Rivette et al.** additionally teaches a method wherein

identifying a first set of one or more data elements includes determining whether the

starting data element includes one or more references to one or more other data

elements and identifying a first set of one or more data elements based on the references

(see disclosure of the PatentRef table storing information on U.S. Patents cited during

the prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element

4028 in drawing Figure 40; see also detailed description of the Patent Citation Module,

col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent

[called a source patent], the patents which were cited during prosecution of the selected

patent [backwards citation report], col. 87, lines 4-10; see also drawing Figure 86).

18.   Regarding claim 3, **Rivette et al.** additionally teaches a method wherein

identifying a second set of one or more data elements includes determining whether

one or more data elements in the database include one or more references to one or

more of the data elements of the first set and identifying a second set of one or more

data elements based on the references (see disclosure of the PatentRef table storing

information on U.S. Patents cited during the prosecution of a given patent, col. 60, line

59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed

description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which

operates to identify, for a particular patent [called a source patent], the patents in which

the source patent was cited [forward citation report], col. 87, lines 11-15; see also

drawing Figure 87).

19.   Regarding claim 4, **Rivette et al.** additionally teaches a method wherein the

starting data element is associated with a starting time and wherein identifying a first

set of one or more data elements includes identifying data elements referenced by the

starting data element and associated with first times earlier than the starting time (see

disclosure of the PatentRef table storing information on U.S. Patents cited during the

prosecution of a given patent, col. 60, line 59 through col. 61, line 6; see also element

4028 in drawing Figure 40; see also detailed description of the Patent Citation Module,

col. 87, line 4 through col. 89, line 53, which operates to identify, for a particular patent

[called a source patent], the patents which were cited during prosecution of the selected

patent [backwards citation report], col. 87, lines 4-10; see also drawing Figure 86; see

also disclosure that filing date is included in the Patent Bibliographic Database, col. 18,

lines 55-66; see also disclosure of extensive search and retrieval functionality and its

relation to patent groups, col. 26 line 38 through col. 31, line 63).

20.   Regarding claim 5, **Rivette et al.** additionally teaches a method wherein

identifying the second set of one or more data elements includes identifying data

elements that reference the data elements of the first set and that are associated with

second times later than the first times (see disclosure of the PatentRef table storing

information on U.S. Patents cited during the prosecution of a given patent, col. 60, line

59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed

description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which

operates to identify, for a particular patent [called a source patent], the patents in which

the source patent was cited [forward citation report], col. 87, lines 11-15; see also

drawing Figure 87; see also disclosure that filing date is included in the Patent

Bibliographic Database, col. 18, lines 55-66; see also disclosure of extensive search and

retrieval functionality and its relation to patent groups, col. 26 line 38 through col. 31,

line 63).

21.   Regarding claim 6, **Rivette et al.** additionally teaches a method wherein

identifying the second set of one or more data elements includes identifying data

elements that reference the data elements of the first set and that are associated with

second times later than the first times and earlier than the starting time (see disclosure

of the PatentRef table storing information on U.S. Patents cited during the prosecution

of a given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing

Figure 40; see also detailed description of the Patent Citation Module, col. 87, line 4

through col. 89, line 53, which operates to identify, for a particular patent [called a

source patent], the patents in which the source patent was cited [forward citation

report], col. 87, lines 11-15; see also drawing Figure 87; see also disclosure that filing

date is included in the Patent Bibliographic Database, col. 18, lines 55-66; see also

disclosure of extensive search and retrieval functionality and its relation to patent

groups, col. 26 line 38 through col. 31, line 63).

22.   Regarding claims 7 and 14, **Rivette et al.** additionally teaches a method further

comprising providing the generated data to one or more of a user and a display (see

drawing Figures 157-164).

23.   Regarding claims 8 and 15, **Rivette et al.** additionally teaches a method further

comprising graphically displaying data elements of the first and second sets and the

relationships therebetween (see drawing Figure 164).

24.   Regarding claims 9 and 16, **Rivette et al.** additionally teaches a method wherein

the publications are represented by geometric shapes and wherein the relationships are

represented by lines between geometric shapes (see drawing Figure 164).

25.   Regarding claims 12 and 13, **Rivette et al.** additionally teaches a method wherein

the publications include one or more of patent publications and non-patent publications

and wherein the patent publications include one or more of issued patents, published

patent applications and non-published patent applications (see disclosure of the

PatentRef table storing information on U.S. Patents cited during the prosecution of a

given patent, col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing

Figure 40).

26.   Regarding claim 18, **Rivette et al.** additionally teaches a method further

comprising based on the second set, identifying one or more candidate patent

publications for one or more of invalidating prior art for the starting patent publication,

licensing opportunities and seminal prior art (see disclosure of the PatentRef table

storing information on U.S. Patents cited during the prosecution of a given patent, col.

60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also

detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53,

which operates to identify, for a particular patent [called a source patent], the patents in

which the source patent was cited [forward citation report], col. 87, lines 11-15; see also

drawing Figure 87; see also disclosure that filing date is included in the Patent

Bibliographic Database, col. 18, lines 55-66; see also disclosure of extensive search and

retrieval functionality and its relation to patent groups, col. 26 line 38 through col. 31,

line 63; see also disclosure of the use of patent citation analysis in competitive analysis

and strategic planning, col. 103, line 24 through col. 108, line 14).

27.   Regarding claims 19 and 25, **Rivette et al.** additionally teaches a method and

processor program wherein identifying one or more candidate patent publications for

invalidating prior art includes identifying one or more patent publications in the second

set that do not cite the starting patent publication that are not cited by the starting

patent publication and that are associated with filing dates earlier than the starting

patent publication (see disclosure of the PatentRef table storing information on U.S.

Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61,

line 6; see also element 4028 in drawing Figure 40; see also detailed description of the

Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to

identify, for a particular patent [called a source patent], the patents in which the source

patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figure

87; see also disclosure that filing date is included in the Patent Bibliographic Database,

col. 18, lines 55-66; see also disclosure of extensive search and retrieval functionality and

its relation to patent groups, col. 26 line 38 through col. 31, line 63; see also disclosure of

the use of patent citation analysis in competitive analysis and strategic planning, col.

103, line 24 through col. 108, line 14).

28.   Regarding claims 20 and 26, **Rivette et al.** additionally teaches a method and

processor program wherein identifying one or more candidate patent publications for

licensing opportunities includes identifying one or more patent publications that are

associated with a first assignee and that are cited by one or more patent publications

associated with one or more different second assignees (see disclosure of the PatentRef

table storing information on U.S. Patents cited during the prosecution of a given patent,

col. 60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see

also detailed description of the Patent Citation Module, col. 87, line 4 through col. 89,

line 53, which operates to identify, for a particular patent [called a source patent], the

patents in which the source patent was cited [forward citation report], col. 87, lines 11-

15; see also drawing Figure 87; see also disclosure that filing date is included in the

Patent Bibliographic Database, col. 18, lines 55-66; see also disclosure of extensive search

and retrieval functionality and its relation to patent groups, col. 26 line 38 through col.

31, line 63; see also disclosure of the use of patent citation analysis in competitive

analysis and strategic planning, col. 103, line 24 through col. 108, line 14, and

specifically the disclosure of identification of potential licensees at col. 103, lines 37-58).

29.   Regarding claims 21 and 27, **Rivette et al.** additionally teaches a method and

processor program wherein identifying one or more candidate patent publications for

seminal prior art includes identifying one or more patent publications that cite a first

number of patent publications that cite a first number of patent publications and that

are cited by a second number of patent publications, wherein the second number is

greater than the first number (see disclosure of the PatentRef table storing information

on U.S. Patents cited during the prosecution of a given patent, col. 60, line 59 through

col. 61, line 6; see also element 4028 in drawing Figure 40; see also detailed description

of the Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to

identify, for a particular patent [called a source patent], the patents in which the source

patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figure

87; see also disclosure that filing date is included in the Patent Bibliographic Database,

col. 18, lines 55-66; see also disclosure of extensive search and retrieval functionality and

its relation to patent groups, col. 26 line 38 through col. 31, line 63; see also disclosure of

the use of patent citation analysis in competitive analysis and strategic planning, col.

103, line 24 through col. 108, line 14).

30.   Regarding claims 22 and 28, **Rivette et al.** additionally teaches a method and

processor program further comprising based on the second set, identifying one or more

co-citing patent publications, the co-citing patent publications including patent

publications of the second set that are associated with one or more of filing dates later

than the filing date of the starting patent publication and publication dates later than

the filing date of the starting patent publication (see disclosure of the PatentRef table

storing information on U.S. Patents cited during the prosecution of a given patent, col.

60, line 59 through col. 61, line 6; see also element 4028 in drawing Figure 40; see also

detailed description of the Patent Citation Module, col. 87, line 4 through col. 89, line 53,

which operates to identify, for a particular patent [called a source patent], the patents in

which the source patent was cited [forward citation report], col. 87, lines 11-15; see also

drawing Figure 87; see also disclosure that filing date is included in the Patent

Bibliographic Database, col. 18, lines 55-66; see also disclosure of extensive search and

retrieval functionality and its relation to patent groups, col. 26 line 38 through col. 31,

line 63; see also disclosure of the use of patent citation analysis in competitive analysis

and strategic planning, col. 103, line 24 through col. 108, line 14).

31.   Regarding claim 23, **Rivette et al.** additionally teaches a method further

comprising based on the co-citing patent publications, determining a patent prosecution

strategy including one or more of filing one or more claims in a pending application,

filing one or more continuing applications of a parent application, declaring one or

more interferences and disclosing one or more of the co-citing patent publications to a

patent-granting office (see disclosure of the PatentRef table storing information on U.S.

Patents cited during the prosecution of a given patent, col. 60, line 59 through col. 61,

line 6; see also element 4028 in drawing Figure 40; see also detailed description of the

Patent Citation Module, col. 87, line 4 through col. 89, line 53, which operates to

identify, for a particular patent [called a source patent], the patents in which the source

patent was cited [forward citation report], col. 87, lines 11-15; see also drawing Figure

87; see also disclosure that filing date is included in the Patent Bibliographic Database,

col. 18, lines 55-66; see also disclosure of extensive search and retrieval functionality and

its relation to patent groups, col. 26 line 38 through col. 31, line 63; see also disclosure of

the use of patent citation analysis in competitive analysis and strategic planning, col.

103, line 24 through col. 108, line 14).

Claim Rejections - 35 USC § 103

32.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

33.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

34.   This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

35.   Claims 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rivette et al.** (U.S. Patent 6,339,767) as applied to claims 1-9, 11-16 and 18-28 above, and further in view of **Coleman et al.** ("Aesthetics-Based Graph Layout for Human Consumption").

36.   Regarding claims 10 and 17, **Rivette et al.** teaches a method of searching a

database of data elements to identify prior art publications for a starting patent

publication substantially as claimed.

        Rivette et al. does not explicitly teach a method further comprising determining

locations at which to display the geometric shapes and lines to reduce overlaps between

geometric shapes and crossings between lines.

        Coleman et al., however, teaches a method further comprising determining

locations at which to display the geometric shapes and lines to reduce overlaps between

geometric shapes and crossings between lines (see disclosure of a number of common-

sense rules for drawing aesthetically pleasing graphs, section 2.1 <u>Layout Aesthetics</u>,

beginning on page 1417).

        It would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate rules for drawing aesthetically pleasing graphs, since this

would result in a graph that maximized the measure of desirability, or aesthetic, in the

resulting graph layout (see Summary, page 1415, et seq.).

Response to Arguments

37.   Applicant's arguments filed 13 July 2006 have been fully considered but they are

not persuasive.

38.   Regarding the Applicants' argument that all of the claimed subject matter is

entitled to the priority date of U.S. provisional application 60/397,542 (22 June 2002)

because "the examiner has failed to acknowledge the other documents to which

Assignee has claimed priority", the examiner respectfully disagrees.

The examiner assumes that by 'other documents', the Applicants are referring to

the related applications cited in the specification in paragraph [0002].

However, these documents are referred to as 'related', and are incorporated by

reference only. Perusal of the Applicants' original transmittal letter, oath/declaration

and specification has confirmed that the Applicants failed to claim priority based upon

any of these documents.

Incorporation by reference is a mechanism whereby other documents can be

relied upon to support 112 first paragraph matters by supplying essential matter that

has been omitted from the specification. It has no bearing on priority.

Establishing a priority date is governed by law (35 U.S.C. §§ 119-120) and rule (37

C.F.R. §§ 1.55 and 1.78), and is completely separate and distinct from incorporation of

essential material by reference.

Since the Applicants' priority claim was to only provisional application

60/397,542, and this provisional application fails to fully support all claims, only those

claims finding support therein are entitled to the priority date of 22 July 2002, as stated

in the 'Priority' section *supra*.

39.   Regarding the Applicants' argument that the claim rejections under 35 U.S.C. §

101 are improper, the examiner respectfully responds that the cited language of §2106 of

the MPEP is not exhaustive of the requirements for a statutory invention. Furthermore,

the Applicants' argument amounts to a mere statement that the claims are statutory,

without explaining why and under what provisions of § 101 and the relevant sections of

the MPEP the claims comply.

The rejections of record are maintained.

40.   Regarding the Applicants' argument that the prior art of record fails to teach the

newly amended limitation of independent claims 1, 11 and 24, the examiner respectfully

disagrees, as detailed in the newly stated rejections of record.

41.   Regarding the Applicants' argument that the **Colman et al.** reference fails to

disclose the 'determining' limitation of claims 10 and 17, the examiner respectfully

disagrees. The language of the reference is fairly explicit, and the specific portions of

the reference where the claimed limitation can be found are specifically cited in the

rejection of record.

        Furthermore, the Applicants have provided no analysis of the claim language

and the prior art, but merely the statement that the prior art fails to teach the limitation.

This statement is not convincing. The rejection is maintained.

42.   Regarding the Applicants' argument that there is no motivation to combine the

Colman et al. reference with the **Rivette et al.** reference, the examiner respectfully

points out that the examiner has cited language providing said motivation directly from

the reference itself. The rejection is maintained.

Conclusion

43.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of

time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and

any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date

of the advisory action. In no event, however, will the statutory period for reply expire

later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Luke S. Wassum whose telephone number is 571-272-

4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate

Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the

examiner at 571-273-4119. Such communications must be clearly marked as

INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Luke S. Wassum
Primary Examiner
Art Unit 2167

lsw
24 August 2006